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No. 95-143

Supreme Court, U.S.
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IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

INTERNATIONAL RECTIFIER CORPORATION,
Petitioner,

v.

SGS-THOMSON MICROELECTRONICS, INC.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether a party that seeks declaratory judgments of patent invalidity and noninfringement has a right to trial by jury on its declaratory judgment claims under the Seventh Amendment?

LIST OF PARTIES AND AFFILIATES

In addition to the parties listed in the caption, SGS-Thomson Microelectronics, S.r.l. (an Italian company) was a defendant in the district court; it was not a party in the court of appeals.

Pursuant to S. Ct. Rule 29.1, the following are the parent companies and non-wholly owned subsidiaries of SGS-Thomson Microelectronics, Inc.:

SGS-Thomson Microelectronics, N.V.

Thorn EMI plc

Thomson-CSF.

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BRIEF IN OPPOSITION

SGS-Thomson Microelectronics, Inc. ("ST"), respectfully submits this brief in opposition to the petition for a writ of certiorari filed by International Rectifier Corporation ("IR"). Because the issue presented by the petition is moot, the petition should be dismissed in accordance with *United States v. Munsingwear, Inc.*, 340 U.S. 36, 39 (1950). If the Court should conclude that the petition is not moot, the petition nevertheless should be denied because the Federal Circuit's decision creates no conflict with the decisions of this Court or other courts of appeals and is, in all events, correct.

DECISIONS BELOW

In addition to the decisions below referred to in the petition, the district court entered an order dismissing the case without prejudice on June 7, 1995, and amended

that order on July 5, 1995. *See* Appendix to Opposition, pp. 5a-7a ("Opp. App."). The Federal Circuit on July 25, 1995, denied IR's Suggestion for Rehearing In Banc and on July 28, 1995, denied IR's request that the court reissue the April 25, 1995, nonprecedential panel opinion in precedential form. *See* Opp. App., pp. 1a-4a.

STATEMENT REGARDING JURISDICTION

Because the case previously pending in the district court has been dismissed and is no longer pending, the jury trial question presented by IR's petition is moot, and this Court therefore lacks subject matter jurisdiction over IR's petition.

After IR filed this patent infringement action in the district court, the United States Patent and Trademark Office ("PTO") initiated reexamination proceedings with respect to both of the IR patents at issue. After the Federal Circuit granted in part ST's petition for mandamus on April 25, 1995—the decision IR challenges in its petition for certiorari—the PTO rejected all claims of both patents that are in any way relevant to this litigation. Because of these determinations by the PTO, ST moved in the district court to dismiss this action without prejudice. The district court granted ST's motion on June 7, 1995. Opp. App., p. 5a. On IR's motion, the district court amended its dismissal order on July 5, 1995, to provide that either party may move to reinstate the case following resolution of the reexamination proceedings in the PTO. Opp. App., pp. 6a-7a; *see* Pet., p. 3 n.2. The July 5 order, however, like the June 7 order, dismissed the action without prejudice and removed the case from the district court's docket. ST submits that, in the present posture of this case, the issue of the right to a jury trial is moot, and the petition should be dismissed. *See infra,* pp. 5-6.

COUNTERSTATEMENT OF THE CASE

ST does not specifically disagree with any of the facts stated in the petition. Nevertheless, to place the issues in their appropriate context requires some additional background.

ST and IR are two of the leading designers and manufacturers of power MOSFETs, tiny transistors used in consumer and industrial electrical switching applications. In this suit, filed on November 13, 1992, IR sought injunctive relief for ST's alleged infringement of two United States patents, No. 5,008,725 and No. 5,130,767, that had been assigned to IR. By way of counterclaim, ST sought, *inter alia,* a declaration that the patents were invalid and unenforceable on various grounds and a declaration that its accused products did not infringe those patents. ST demanded a trial by jury on its counterclaims.

While the litigation was pending in the district court, ST petitioned the United States Patent and Trademark Office ("PTO") to reexamine IR's patents. *See* 35 U.S.C. § 302. Presently, the PTO has, in the reexamination proceedings, rejected all of the claims of IR's patents that are relevant to this litigation. It was on this basis that ST moved the district court to dismiss the case and that the district court granted that motion, albeit without prejudice to either party moving to restore the case to the docket after the conclusion of the reexamination proceedings. *See* Opp. App., pp. 5a-7a.

As IR notes, prior to the PTO action and prior to the district court's dismissal order, ST petitioned the United States Court of Appeals for the Federal Circuit to issue a writ of mandamus directing that ST's declaratory judgment claims be tried to a jury. The Federal Circuit granted that petition for mandamus in part. After IR filed its petition for certiorari, the Federal Circuit denied IR's Suggestion for Rehearing In Banc. Opp. App., pp. 1a-3a.

REASONS FOR DENYING THE PETITION

As a preliminary matter, this Court should dismiss the petition for lack of jurisdiction. The underlying controversy—whether ST has a right to a jury trial on its claims for declaratory judgments that IR's patents are invalid and that ST did not infringe those patents—is moot. There is presently no case pending before the district court; the possibility that the case may someday be reinstated and the parties may someday proceed to trial is too contingent to support subject matter jurisdiction over the petition. The petition should therefore be dismissed in accordance with *United States v. Munsingwear, Inc.*, 340 U.S. 36, 39 (1950).

Even if the petition is not moot, it should be denied for three reasons. First, the Federal Circuit's decision creates no conflict with the decisions of this Court. IR's assertion to the contrary—that declaratory judgment actions are always (and only) equitable and therefore the Seventh Amendment right to a jury trial never attaches—simply misreads the controlling precedents of this Court. Second, the Federal Circuit's decision creates no conflict with any decisions of other courts of appeals. The cases IR cites either do not squarely address the issue or have been superseded by *Cardinal Chemical Co. v. Morton International, Inc.*, 113 S. Ct. 1967 (1993), in which this Court held that a declaratory judgment action presents an independent claim which must be considered on its own merits. Finally, the Federal Circuit's decision was, in all events, correct. The court of appeals properly applied the established test for determining the right to a jury trial under the Seventh Amendment when it decided that an action seeking declaratory judgments of patent invalidity and noninfringement was analogous to an inverse infringement suit at common law and accorded the parties the right to a jury trial. The Federal Circuit's result is also correct when viewed in light of the writ of *scire facias*, which was the means by which a private party

sought to have a patent declared invalid in 18th-Century England. In such a proceeding, the party seeking to have the patent nullified had a right to trial by jury.

1. Because the underlying case presently is not pending before the district court, this Court lacks subject matter jurisdiction over the question IR presents in its petition. The petition therefore should be dismissed in accordance with *United States v. Munsingwear, Inc.*, 340 U.S. 36, 39 (1950). Although, prior to the district court's dismissal order, the parties had a live case or controversy concerning ST's entitlement to a jury trial on its declaratory judgment claims, the dismissal has mooted that issue. Accordingly, any ruling on this issue by this Court at this time would be purely advisory.

Even in cases in which the parties had a live controversy at the time the court of appeals ruled, Article III requires that a live case or controversy continue to exist before this Court. "That the dispute between the parties was very much alive when suit was filed, or at the time the Court of Appeals rendered its judgment, cannot substitute for the actual case or controversy that an exercise of this Court's jurisdiction requires." *Honig v. Doe*, 484 U.S. 305, 317 (1988). Determination of whether ST has a right to jury trial on its claims for declaratory judgments of invalidity and noninfringement will not resolve any "real and substantial controversy admitting of specific relief through a decree of conclusive character" but rather would provide only "an opinion advising what the law would be upon a hypothetical state of facts." *Aetna Life Ins. Co. v. Haworth*, 300 U.S. 227, 241 (1937).

It is true that the parties may again face the issue of ST's right to a jury trial in this case: the PTO may ultimately permit some claims to issue in some form with respect to one or both of the patents at issue; one of the parties may move the district court to reinstate the case to the docket (and the district court may in fact do so); ST may conclude that it wishes to pursue a declaratory

judgment invalidating IR's patent claims (however they may be redefined following the reexamination proceedings); and ST or IR may decide that it wishes to have that claim tried to a jury. But this series of contingencies that must be resolved before the jury trial issue will arise again clearly establishes that there is no "specific live grievance" presently before the Court. *Golden v. Zwickler*, 394 U.S. 103, 110 (1969). Similarly, it may be the case—as IR asserts—that the right to jury trial on declaratory judgment claims in patent cases presents an important question (Pet., pp. 6-9), "but the Article III question is not whether the requested relief would be nugatory as to the world at large, but whether [the litigant before the Court] has a stake in that relief." *Lewis v. Continental Bank Corp.*, 494 U.S. 472, 479 (1990). IR, the litigant here, presently has no such stake, and the petition therefore should be dismissed.[1]

2. Even if the issue the petition presents is not moot, the petition should be denied because the Federal Circuit's decision presents no inconsistency with this Court's declaratory judgment cases. IR asserts that the Federal Circuit erred in finding a right to jury trial because

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[1] Even if the jury trial issue is not technically moot, the contingencies presented by the PTO reexamination proceedings nevertheless counsel against reviewing that question at this juncture. The reexamination proceedings may result in patent claims somewhat (or even substantially) different from the claims that were initially the subject of this suit. This Court has previously held that "[w]hile the ultimate question of patent validity is one of law, [it] lends itself to several basic factual inquiries." *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Those factual inquires—indeed, even the question whether there are any disputed questions of material fact—will turn on the precise claims that emerge from the reexamination proceedings. "Justiciability concerns not only the standing of litigants to assert particular claims, but also the appropriate timing of judicial intervention." *Renne* v. *Geary*, 501 U.S. 312, 320 (1991). If and when all of the contingencies are resolved and the parties are again facing a trial on the merits, mandamus review by the Federal Circuit and review by this Court of any questions concerning the right to jury trial will be available.

"declaratory relief is predominantly equitable in nature [a]nd this Court has held, as a matter of constitutional law, that no right to a jury trial attaches to claims historically tried to courts of equity." Pet., p. 19. Although IR is correct that there is no right to jury trial in equitable actions, its assertion that declaratory judgment actions are always and exclusively equitable simply misreads this Court's decisions.

This Court, in fact, in *Simler v. Conner*, 372 U.S. 221 (1963), rejected the precise argument IR now makes. There, the respondent argued that declaratory judgment actions were " 'equitable' and not 'legal' in character" and therefore the right to jury trial did not attach. *Id.* at 222. The Court concluded that the form of the action was irrelevant to the resolution of the Seventh Amendment question: "The fact that the action is in form a declaratory judgment case should not obscure the essentially legal nature of the action." *Id.* at 223. Instead, in determining whether there is a right to a jury trial in a given declaratory judgment case, the courts should look to the "basic character" of the issues in the suit to determine whether they are issues to which a right to a jury trial traditionally attached. *Id.* ("The case was in its basic character a suit to determine and adjudicate the amount of fees owing to a lawyer by a client under a contingent fee retainer contract, a traditionally 'legal' action."). *See also Ross v. Bernhard*, 396 U.S. 531, 538 (1970) ("The Seventh Amendment question depends on the nature of the issue to be tried rather than the character of the overall action.").

Similarly, in *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500 (1959), this Court stated that "[t]he District Court's finding that the Complaint for Declaratory Relief presented basically equitable issues draws no support from the Declaratory Judgment Act. That statute, while allowing prospective defendants to sue to establish their nonliability, specifically preserves the right to jury trial for both parties." *Id.* at 504. Statements in other deci-

sions of this Court (*see* Pet., p. 18 n.9[2]) that district courts have discretion whether or not to entertain declaratory judgment actions therefore have nothing to do with the scope of Seventh Amendment rights in those cases. And IR's assertion that the Federal Circuit has misread *Beacon Theatres* (Pet., p. 19) is without basis.

In this regard, IR simply confuses the issue that was before the Federal Circuit: whether ST had a right to a jury trial on its declaratory judgment claims. IR inexplicably focuses on whether *its* claim, which it cast solely as a claim for injunctive relief, gives rise to a right to trial by jury. *See* Pet., p. 20 (stating that "[b]ecause IR has chosen to sue only on a purely equitable claim for an injunction, *no* jury trial right arises"); *see also* Pet., p. 10 ("one need not look beyond IR's claims —for an injunction *only*"). As the Federal Circuit correctly recognized, whether any party has a right to a jury trial on IR's injunctive action is simply irrelevant. "The presence of IR's request for injunctive relief does not take" ST's claims "away from the jury." App., p. 3.

IR makes a similar mistake when it repeatedly argues that "nothing whatsoever was added [to the case in the district court] by ST's counterclaims for declaratory relief." Pet., p. 4; *see also* Pet., pp. 7, 15, 19. These assertions are flatly contrary to this Court's decision in *Cardinal Chem. Co. v. Morton Int'l, Inc.*, 113 S. Ct. 1967 (1993). There, the Court reversed the Federal Circuit's practice of routinely vacating district court declaratory judgments of patent invalidity where the court of appeals had found that the patents-at-issue were not infringed. This Court held, "A party seeking a declaratory judgment of invalidity presents a claim independent of the patentee's charge of infringement." *Id.* at 1975.

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[2] Citing *Samuels v. Mackell*, 401 U.S. 66, 70-71 (1971); *Abbott Labs. v. Gardner*, 387 U.S. 136, 155 (1967); *Public Affairs Assoc. v. Rickover*, 369 U.S. 111, 112 (1962); *Eccles v. Peoples Bank of Lakewood Village*, 333 U.S. 426, 431 (1948).

Absent a declaratory judgment counterclaim, a defendant asserting both noninfringement and invalidity has no means to force the resolution of the validity question. *Compare id.* at 1973 (court may vacate findings of invalidity when invalidity is presented only as an affirmative defense). This Court in *Cardinal Chemical* specifically "emphasized the importance to the public at large of resolving questions of patent validity." *Id.* at 1977 (citing *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313 (1971)).

3. The Federal Circuit's decision is not in direct conflict with any decision of another court of appeals. As a threshold matter, IR concedes that "Federal Circuit decisions . . . do not create conflicts among the circuits because the Federal Circuit maintains exclusive subject matter jurisdiction over patent appeals. *See* 28 U.S.C. § 1295(a)(1)." Pet., p. 13. IR nevertheless strains to create a conflict between the Federal Circuit's decision here (and in *In re Lockwood*, 50 F.3d 966 (Fed. Cir.), *cert. granted*, 115 S. Ct. 2274 (1995)) and two cases from the Ninth Circuit: *Shubin v. United States District Court*, 313 F.2d 250 (9th Cir.), *cert. denied*, 373 U.S. 936 (1963), and *Anti-Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296 (9th Cir. 1979), *cert. denied*, 459 U.S. 1227 (1983). As the Federal Circuit held in *Lockwood*, 50 F.3d at 977, no conflict exists.

In both *Shubin* and *Anti-Monopoly*, the courts noted that no claims for damages were pending and simply assumed, without analysis, that all of the remaining claims sought only equitable relief. *Shubin*, 313 F.2d at 251-52; *Anti-Monopoly*, 611 F.2d at 307-08. Neither case treated the declaratory judgment claims as independent claims requiring independent consideration. *Compare Lockwood*, 50 F.3d at 977 ("In neither *Shubin* nor *Anti-Monopoly*, however, did the Ninth Circuit address whether an action for a declaratory judgment of invalidity standing alone entitles the defendant patentee to a jury trial on the factual questions relating to validity as a matter

of right."). But *Cardinal Chemical* teaches that declaratory judgment claims are independent claims (113 S. Ct. at 1975), and those claims must therefore be independently analyzed for Seventh Amendment purposes. Moreover, in *Shubin*, "[t]he court focused . . . on the sort of action the defendant patentee could have brought at common law to raise the issues presented in the case." *Lockwood*, 50 F.3d at 977. "Because the parties had stipulated to the fact that no infringement had yet occurred" (*id.*), the patentee would not have had even the theoretical possibility of a common law damages action. In contrast, a patentee in IR's position at common law could have elected to sue for damages. *See Shubin*, 313 F.2d at 251. And, in *Anti-Monopoly*, the party seeking a jury trial did not argue that its declaratory judgment claims standing alone entitled it to a jury, but rather relied entirely on the fact that claims for damages, since dismissed, had once been part of the case. *See Anti-Monopoly*, 611 F.2d at 307. Neither case therefore calls into question the correctness of either *Lockwood* or the Federal Circuit's decision here.

4. This Court also should decline certiorari because the Federal Circuit's decisions here and in *Lockwood* were correct. Initially, the *Lockwood* court properly followed the analytical framework required by the Seventh Amendment, and IR's assertions to the contrary are completely unfounded. *Compare* Pet., pp. 10-13. Specifically, the *Lockwood* court applied "the controlling test" and decided that Lockwood had a right to a jury trial on the declaratory judgment counterclaim because issues of invalidity arose in the pre-1791 English courts as defenses to patent infringement actions. Because a patentee could elect to seek infringement damages in the English courts of law, issues of invalidity raised by the defendant could be decided by a jury. *Lockwood*, 50 F.3d at 971-80.

IR's suggestion that the Federal Circuit erred in applying its *Lockwood* reasoning in this case because IR sought only injunctive relief (Pet., pp. 10-11) simply misreads

Lockwood. The *Lockwood* court decided that an action for a declaratory judgment of patent invalidity required a trial by jury because patent invalidity was an issue that could arise in the English common law courts. The actual presence of a damages claim in a particular case was irrelevant. In this light, IR's complaint that *Lockwood* "jettisoned" (Pet., p. 11) the controlling Seventh Amendment test when it decided that actions seeking declaratory judgments of patent invalidity require the "adjudication of legal rights" and therefore carry with them the right to a jury trial is misplaced. As previously discussed, this Court in *Simler* held that a right to jury trial attached in that declaratory judgment case because the declaratory judgment claim there required the adjudication of contract issues that were traditionally legal in nature.

As the Federal Circuit in this case acknowledged, however, the principle recognized in *Lockwood* cannot be limited to the unexceptional proposition that a patentee who sues for damages has a right to have his claim and the common factual issues in a counterclaim for a declaration of invalidity heard by a jury. That proposition was established beyond cavil in *Beacon Treatres*, as even IR recognizes in its petition. *Compare* Pet., p. 19. As this Court made clear in *Cardinal Chemical*, a declaratory judgment claim is a separate and distinct claim that must be addressed on its own merits.

In this regard, IR's argument that the relief sought by ST's declaratory judgment action is not legal relief because ST does not seek "monetary damages or recovery of real or personal property" is fundamentally misdirected. Pet., pp. 16-17. As this Court held in *Simler*, *Ross*, and *Beacon Theatres*, declaratory judgment relief is as legal or equitable as the underlying controversy and, as the Federal Circuit properly recognized, claims of invalidity (and noninfringement) present legal controversies. Moreover, a patent is a property right, and an action for a declaration of patent invalidity seeks a ruling that the

patentee must be divested of that claimed property right. *Compare Pernell v. Southall Realty*, 416 U.S. 363, 370 (1974) (action for ejectment is "at law triable to a jury").

The *Lockwood* court's discussion of the writ of *scire facias* as a historical antecedent to an action for a declaratory judgment of invalidity further supports the Federal Circuit's holding in this case that all parties in the action have the right to a jury trial on ST's declaratory judgment counterclaims. *See* 50 F.3d at 974 n.9. As the *Lockwood* court noted, the English writ of *scire facias* was very similar to a declaratory judgment action, and in *scire facias* proceedings a jury resolved the factual issues. *Lockwood*, 50 F.3d at 974 n.9. A careful review of the historical evidence establishes that *scire facias* is an appropriate analogy for Seventh Amendment purposes in this case because, contrary to some questions raised in *Lockwood*, a private party could initiate a *scire facias* proceeding as a matter of right at common law and could seek a *scire facias* for invalidity.

First, English practice at common law provided that the writ of *scire facias* could be used by a private party to challenge a patent. Although a *scire facias* proceeding was brought in the name of the king, it was a remedy available as a matter of right to his subjects. Blackstone explains:

> Where the crown hath unadvisedly granted any thing by letter patent, which ought not to be granted, or where the patentee hath done an act that amounts to a forfeiture of the grant, the remedy to repeal the patent is by writ of *scire facias* in chancery. This may be brought either on the part of the king in order to resume the thing granted; or if the grant be injurious to a subject, the king is *bound* of right to permit him (upon his petition) to use his royal name for repealing the patent in a *scire facias.*

3 William Blackstone, *Commentaries on the Law of England* **260-61 (emphasis added). *See also Attorney Gen-*

eral ex rel. Hecker v. Rumford Chemical Works, 32 F. 608, 618 (C.C.D.R.I. 1876) ("The action of scire facias was not only a remedy provided by law for the crown in behalf of the public, but also for any subject of the crown who could show that a void or illegal patent operated to his prejudice"); *Mowry v. Whitney*, 81 U.S. (14 Wall.) 434, 440 (1871) ("when a patent is granted to the prejudice of the subject, the king of right is to permit him upon his petition to use his name for the repeal of it, in *scire facias* at the king's suit").[3]

Second, as recognized in Judge Nies' dissent from the denial of rehearing *in banc* in *Lockwood*, it was established at common law that a writ of *scire facias* could issue based on a determination that a patent was invalid as well as a determination that it had been procured by fraud. 50 F.3d at 984-85 (citing *Mowry*, 81 U.S. at 439, and *United States v. Stone*, 69 U.S. (2 Wall.) 525, 535 (1864)); *see also* Edward Coke, *The Fourth Part of the Institutes of the Laws of England* *88. The Federal Circuit in *Lockwood* concluded otherwise (50 F.3d at 974 n.9) because it misinterpreted this Court's opinion in *Ex parte Wood*, 22 U.S. (9 Wheat.) 603, 609 (1824)—in which Justice Story wrote that *scire facias* issued at common law "to repeal patents which have been obtained surreptitiously, or upon false suggestion"—to mean that *scire facias* was available only to repeal fraudulently obtained patents. *See Lockwood*, 50 F.3d at 974 n.9. However, as Justice Story himself elsewhere made clear, *scire facias* would lie based upon allegations of invalidity, as well as allegations of fraud. In his commentary on the patent laws, Justice Story explained that the procedure "to try the validity of a patent . . . is in the nature of a *scire facias* at the common law." Joseph Story, *On the*

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[3] Early United States cases that hold that only the government can seek a declaration of patent invalidity (*e.g.*, *United States v. American Bell Telephone Co.*, 128 U.S. 315 (1888)) reflect only American law which, after the patent law revision of 1836, eliminated the prior private right of action. *See id.* at 371.

Patent Laws, 16 U.S. (3 Wheat.) app. 13, 28 (1818). In fact, "[t]he judgment in a *scire facias* for repealing a patent [was] 'that the said letters patent of our said lord the King be revoked, cancelled, vacated, annulled, void, and *invalid*.'" *Underhill v. Devereux*, 2 Wms. Saund. 72, 85 Eng. Rep. 733 (K.B. 1671) (editor's notes) (emphasis added).[4]

Third, in 18th-Century England and in the United States before the patent law revision of 1836, it was established that a *jury* decided the factual issues in a private action for *scire facias*. At common law, as Blackstone explained (*see supra*, p. 12), *scire facias* was sought in chancery. 3 William Blackstone, *Commentaries on the Law of England* **260-61. The English Court of Chancery, in which a writ of *scire facias* was pursued, had two courts: "the one ordinary, being a court of common law; the other extra-ordinary, being a court of equity. The ordinary legal court is much more ancient than the court

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[4] The leading commentator on *scire facias* elaborates:

> A scire facias lies to repeal a patent granted for an invention not invented or introduced into the kingdom by the patentee, or which is not new and useful to the public, or which is void for uncertainty, for being too general, or for false suggestions by which the Queen has been misinformed in her grant, or where the same thing has been granted to two persons.

Thomas Campbell Foster, *A Treatise on the Writ of Scire Facias* *368 (1851).

Two cases decided just six years before the ratification of the Bill of Rights similarly illustrate the fact that *scire facias* was the proper action to obtain a declaration of patent invalidity. *Rex v. Else*, 1 Carp. P.C. 103 (K.B. 1785), "was a proceeding by writ of *scire facias* to repeal the patent on the ground that there was no new invention described in the specification." *Id.* After hearing testimony, the court concluded that "the patent is clearly void, and the jury must find for the crown." *Id.* at 105. Similarly, *Rex v. Arkwright*, 1 Carp. P.C. 53 (K.B. 1785), was an action on a *scire facias* to declare a patent invalid because "the invention, at the time of granting the letters patent, was not a new invention." *Id.* at 53. The jury found the machine lacking in invention, and thus the court invalidated the patent. *See id.* at 57, 103.

of equity. Its jurisdiction is to hold plea upon a *scire facias* to repeal and cancel the king's letters patent." 3 *id.* at *47. Factual issues in a *scire facias* proceeding were tried to a *jury* at common law. *See Lockwood*, 50 F.3d at 974 n.9; *see also Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 1010-15 (Fed. Cir. 1995) (in banc) (Newman, J., dissenting) (collecting 18th Century English cases); *Ex parte Wood*, 22 U.S. (9 Wheat.) 603, 613-14 (1824) (Story, J.) ("If a patent has been fraudulently obtained, or upon false suggestions, it may be repealed within three years, if a jury, upon a trial, shall be satisfied of the fact"); *Attorney General ex rel. Hecker*, 32 F. at 619 (a *scire facias* action "was a *quasi* common-law proceeding, with the right of trial by jury"); Neil Davenport, *The United Kingdom Patent System: A Brief History* 78 (1979) ("the validity of the patent was then tried, usually with a jury in the Court of the King's (or Queen's) Bench").

In essence, the Declaratory Judgment Act, by permitting a private party to seek an adjudication of the validity of a patent, whether or not the patentee sued first, reinstated that branch of *scire facias* practice by which private parties could seek a determination that a patent was invalid at common law. And, as explained above, there is a well-established right to try such a claim to a jury. *Compare Beacon Theatres*, 359 U.S. at 509 (the Declaratory Judgment Act, and the liberalization of the rules of civil procedure, effectuated an "expansion of adequate legal remedies"); *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 478 (1962) (ability of court to appoint a special master to assist jury with complicated damages calculations meant that equitable action for accounting (without a jury) could not in general be maintained).

Of course, ST's right, as a declaratory judgment plaintiff, to a jury trial under the Seventh Amendment does not turn on whether the common law writ of *scire facias* in all respects mirrors the present action for a declaratory judg-

ment of patent invalidity or noninfringement. As this Court explained in *Curtis v. Loether:*

> By *common law,* [the Framers of the Seventh Amendment] meant . . . not merely suits, which the *common* law recognized among its old and settled proceedings, but suits in which *legal* rights were to be ascertained and determined, in contradistinction to those where equitable rights alone were recognized.

415 U.S. 189, 193 (1974) (emphasis in original). "Whether or not a close equivalent to [an action] existed in England in 1791 is irrelevant for Seventh Amendment purposes, for that Amendment requires trial by jury in actions unheard of at common law, provided that the action involves rights and remedies of the sort traditionally enforced in an action at law, rather than in an action in equity or admiralty." *Pernell,* 416 U.S. at 375. At common law, factual issues in a *scire facias* for patent invalidity were determined by a jury.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be dismissed for lack of jurisdiction. In the alternative, if the Court concludes that it does not lack jurisdiction over the petition, certiorari should be denied.

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